

DRAWING AMENDMENTS

The attached sheet of drawings includes changes to Figure 1. This sheet, which includes Figure 1, replaces the original sheet including Figure 1.

Attachment: Replacement Sheet

REMARKS**A. Request for Reconsideration**

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the claims and the following remarks.

B. The Invention

The present invention is directed to an electrostatic latent image developing toner and image forming methods employing the same. According to one of the novel aspects of the invention, the toner is composed of colored particles and external additive particles, wherein a volume average particle diameter of the toner is 4.0-8.0 μm , and wherein a sum of the colored particles and the external additive particles having a particle diameter of at most 2.5 μm is 0.1-10 percent by volume.

The incorporation of the toner particles in the claimed volume percentage improves the fluidity and transferability of the small diameter toner. Thus, the toner of the invention does not film or adhere on the

photoreceptor and it is possible to form consistent images over extended periods of time (page 11, lines 9-17).

C. Restriction Requirement

A restriction requirement had been put forward between Group I, claims 1-8 drawn to a toner, and Group II, claims 9-12 drawn to image forming methods. Applicants had provisionally elected with traverse to prosecute Group I, claims 1-8.

Applicants affirm the election of Group I. However, Applicants wish to traverse the restriction requirement since it is believed that claims 9-12 drawn to image forming methods utilizing the toner of claim 1 should be subject to rejoinder when the toner of claim 1 is allowed. Applicants note that claims 9-12 are each dependent upon claim 1.

Reconsideration of the restriction requirement is respectfully requested.

D. Claim Amendments

Claims 1-12 were original claims in this Application, claims 9-12 having been withdrawn from consideration. This amendment adds claims 13-24. Claims 1-8 and 13-24 are therefore presented for further prosecution.

Claims 1-8 have been amended to correct minor grammatical errors. Claim 8 has also been amended to delete the final portion.

Claims 13-15 have been added to further define the toner of claim 1. Support for claim 13 can be found at page 19, lines 11-14. Support for claim 14 can be found at page 20, lines 1-9. Support for claim 15 can be found at page 35, lines 4-19.

Claims 16-24 have been added to recite a preferred toner of the invention. Support for claims 16 and 17 can be found in claims 1-3. Support for claims 18-20 can be found in claims 13-15. Support for claims 21-24 can be found in claims 4-7.

E. Objections to the Drawings

The drawings had been objected to because they include reference characters 24, 5Y, 5M, 5C and 5K not mentioned in the description.

Page 48 has been amended to specify that "ejection rollers 17" are "ejection rollers 24" to provide support for the reference character "24" in Figure 1.

Applicants request that Figure 1 be replaced by the enclosed Replacement Sheet. The illustration of 5Y, 5M, 5C and 5K has been deleted from Replacement Figure 1.

It is deemed that Figure 1 is fully described in the specification.

F. Objections to the Specification

Page 46 (pages 44 and 45) of the specification had been objected to for referring to reference character "d", while Figure 1 contains reference character "D". Page 48 had been objected to for identifying the ejection rollers with reference character "17". Finally, the use of trademarks had been objected to since the trademarks had not been capitalized.

Applicants have made appropriate corrections herein. Reference character "d" has been changed to "D" at pages 44 and 45, "ejection rollers 17" has been changed to "ejection rollers 24", and the trademarks have been capitalized.

G. Objection to Claim 8

Claim 8 had been objected to for containing a duplicate limitation from claim 1. Claim 8 has been amended to delete this limitation.

H. Rejections under 35 USC § 102 and § 103

Claims 1 and 4 had been rejected as being anticipated by or unpatentable over EP 0331425 (EP '425), while claims

1, 2 and 4 had been rejected as being anticipated by or unpatentable over Mitsuhashi (US 6,656,653).

EP '425 and Mitsuhashi had been cited to teach toner particles composed of colored particles and a silica additive. The Examiner had taken the position that both EP '425 and Mitsuhashi teach the claimed volume average particle diameter of the toner, as well as the claimed volume percentage of the sum of the colored particles and additive.

1. EP '425 and Mitsuhashi do not anticipate the claimed volume percentage of the sum of the colored particles and the additive

The Examiner had stated that the amount of 10% by volume of particles having a particle size of $\leq 5 \mu\text{m}$ as taught in Tables 1 and 2 of EP '425 is within the claimed range of 0.1 to 10% by volume of particles having a particle size of $\leq 2.5 \mu\text{m}$ (page 11, line 20 to page 12, line 2 of the Office Action). Similarly, the Examiner had concluded that the value of 3.5% by volume of particles having a particle size of $\leq 5 \mu\text{m}$ as taught in Example 1 of Mitsuhashi is also within the claimed range of 0.1 to 10% by volume of particles having a particle size of $\leq 2.5 \mu\text{m}$

(page 13, lines 3-8 of the Office Action). The Examiner had therefore stated that both EP '425 and Mitsuhashi anticipate the present invention.

Applicants submit that both EP '425 and Mitsuhashi do not anticipate the present invention, since both references teach volume percentages for particle sizes of $\leq 5 \mu\text{m}$, not $\leq 2.5 \mu\text{m}$ as recited in claim 1. The Examiner should not assume that the volume percentages for the larger particle size of μm of EP '425 and Mitsuhashi can be correlated to the smaller particle size of $\leq 2.5 \mu\text{m}$ as recited in claim 1. Applicants remind the Examiner that an anticipation rejection under § 102 requires that a reference teach each element of the claimed invention with sufficient particularity to prove its existence in the reference. Respectfully, it is submitted that EP '425 and Mitsuhashi do not anticipate the present invention based on the lack of an explanation of the volume percentage for particles $\leq 2.5 \mu\text{m}$.

2. The present invention is not anticipated since EP '425 and Mitsuhashi do not teach the particle size or the volume percentage of the additive

The Inventors explain that the proportion of additives in terms of particle size and volume percent should be considered to ensure that the additives are easily releasable from the colored particles in order to maintain desired fluidity of the toner, to stabilize charging properties and to improve transferability (page 15, lines 15-22).

In contrast to the present invention, EP '425 and Mitsuhashi do not teach or suggest that the particle size or the volume percentage of the additive should be considered when preparing the toner. It is therefore not possible to determine whether EP '425 or Mitsuhashi teach the 4.0-8.0 μm diameter distribution of claim 1, since the diameter distribution is based on the toner which includes the additive.

It is therefore submitted that claim 1 is not anticipated since the diameter distribution of the toner including the additive cannot be accurately calculated.

3. The present invention is not obvious since EP '425 and Mitsuhashi do not teach the criticality of the volume percentage of the particles

Tables 4 and 5 at pages 60-61 of the Application show the criticality of the volume percentage of particles of ≤ 2.5 being 0.1-10% as claimed. For example, film formation and black streaking occurred for Comparative toners 1BK, 1Y, 1M and 1C falling above the claimed 10% range, while the remaining Inventive toners within the claimed range formed excellent images without filming.

EP '425 and Mitsuhashi do not teach or suggest the criticality of the claimed 10% volume percentage demonstrated in Tables 4 and 5 of the invention. Thus, it would not be obvious to arrive at the present invention based on the teachings of EP '425 and Mitsuhashi.

It is respectfully submitted that the present invention is not obvious over the cited references since the references are silent with respect to the criticality of the claimed volume percentage.

4. EP '425 teaches that the particles $\leq 2.52 \mu\text{m}$ are present in an amount of 0% by volume

Table 1 at page 13 of EP '425 clearly shows that the colored particles (without the additive) are present at 0%

by volume for the particle size range of 2.00-2.52 μm . EP '425 therefore specifically teaches that the colored particles at a size of approximately 2.5 μm are present in a volume% below the claimed range of 0.1-10%.

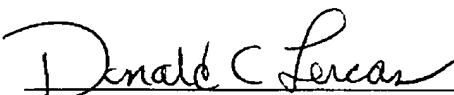
It is therefore respectfully submitted that the present invention is patentable over EP '425.

I. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

MUSERLIAN, LUCAS & MERCANTI, LLP

By: 
Donald C. Lucas, 31,275
Attorney for Applicant(s)
475 Park Avenue South, 15th Floor
New York, New York
Tel. # 212-661-8000

Encl: One replacement drawing sheet
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